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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,598	09/10/2003	Miri Seiberg	JBP-430-CIP1	5368

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NEW BRUNSWICK, NJ 08933-7003

EXAMINER
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GEMBEH, SHIRLEY V

ART UNIT	PAPER NUMBER
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1628

NOTIFICATION DATE	DELIVERY MODE
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09/02/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com  
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gsanche@its.jnj.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,598	<b>Applicant(s)</b> SEIBERG ET AL.	
	<b>Examiner</b> SHIRLEY V. GEMBEH	<b>Art Unit</b> 1628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 73-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 73-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/13/10 has been entered.
2. Applicant's argument filed on 8/13/10 has been fully considered but they are not deemed to be persuasive.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 73-86 are pending in this office action.
5. The declaration filed on 8/13/10 under 37 CFR 1.131 is sufficient to overcome the Jin (CN166960A) reference, however this is a rejection under 35 USC 103 and Kennedy (US patent 5,338,547) is been added to the rejection below for the use of a non-denatured soy bean extract in treating pre-malignant skin.

Applicant's arguments with respect to claims 73-86 rejected under 35 U.S.C. 103(a) as being unpatentable over Jin (CN166960A published 12/10/1997) in view of Meybeck et al. (US 5,034,228) have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 73-86 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jin (CN166960A published 12/10/1997) in view of Meybeck et al. (US 5,034,228), and further in view of Kennedy (US patent 5,338,547).

The courts have held that if the product (i.e., a soybean extract) in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); *In re Marosi*, 218 USPQ 289, 292-293 (Fed. Cir. 1983).

This rejection is also consistent with that held by the courts in *Ex parte Gray*, 10 USPQ 2d 1922 (1989); *In re Best*, 195 USPQ 430 (CCPA 1976), which held that:

Likewise, the courts have held that when the prior art product reasonably appears to be the same as that claimed, but differs by process in which it is produced, a rejection of this nature is eminently fair and the burden is upon the appellants to prove, by comparative evidence, a patentable difference (*In re Brown*, 173 USPQ 685 (1972)).

Jin teaches a composition comprising soybean protein powder for treating the face, wherein after several application of the mask, the acne is obviously decreased (see translated abstract, as required by instant claims 73, 75, 77, 78). Because Jin teaches that the powders of these natural products are mixed, it is reasonable to conclude that the mixing involves the use of water, and therefore the powder will form a paste when in contact with a liquid or a solvent. Thus it is reasonable to conclude that Jin teaches soybean paste as well (as required by instant claim 74).

However Jin fails to teach the composition for reducing/treating acne further comprises tretinoin.

Meybeck et al. teach treating acne with soya lecithin and tretinoin (as required by instant claims 73-74 and 76-78 are met see col. 3, lines 36-38 and lines 61-64) wherein the application is topical (as required by instant claim 83, see col. 3, lines 35- 37. With regard to claim 75, the Meybeck teaches tretinoin as vitamin A, (see col. 2, line 42). Meybeck et al. also teaches the formulation may comprise 2 g of soy lecithin and 0.1 g of tretinoin which is within the recited limitations of 0.01 to about 0.3% tretinoin and 0.01-50% of soybean in claims 79, 81-83 and 85-86 (see col. 3, line 62).

However Meybeck fails to teach that the treatment method comprises soy powder.

Kennedy teaches a method of treating pre-malignant tissue and the inhibition of skin cancer with a composition containing a Bowman-Birk Inhibitor Concentrate (BBIC), which is a non-denatured soy product that may be topically applied.

It would have been obvious to one in the method of treatment taught by Jin for the Bowman-Birk Inhibitor Concentrate (a non-denatured soy product) into a paste or milk forms as taught by Jin to include treating acne taught by Meybeck. Since Jin's method of treatment comprises natural bean flour, one of ordinary skill in the art would have been motivated to substitute the mung bean flour with a soybean flour with a reasonable amount of success. It is reasonable that water is added to the composition to form a masque thus would necessarily form a paste. Therefore the use of soy flour is equivalent to using soy paste as required by instant claim 74. Since tretinoin is known in

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the art to be interchangeable with retinoid or vitamin A, one of ordinary skill in the art would have employed either tretinoin or vitamin A in a composition for treating acne since vitamin A is well known in the art for treating acne.

7. No claim is allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY V. GEMBEH whose telephone number is (571)272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571-272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S.V.G./  
Examiner, Art Unit 1618  
8/24/10

/Robert C. Hayes/  
Primary Examiner, Art Unit 1649